

ESTTA Tracking number: **ESTTA596829**

Filing date: **04/07/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215038
Party	Defendant Kiaico, Inc.
Correspondence Address	Dan Healy CEO 10th. Floor 445 Park Avenue New York, NY 10022 iplegal@kiaicoinc.com
Submission	Answer and Counterclaim
Filer's Name	Dan Healy
Filer's e-mail	iplegal@kiaicoinc.com
Signature	/MRKIAI/
Date	04/07/2014
Attachments	Counterclaim to Cancel RN 3940239 in Proceeding 91215038.pdf(26951 bytes)

Registration Subject to the filing

Registration No	3940239	Registration date	04/05/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	Marshall Amplification plc Denbigh Road, Bletchley, Milton Keynes Buckinghamshire, GBX MK11DQ GBX		

Goods/Services Subject to the filing

Class 025. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Clothing, headwear and footwear, namely, T-shirts, polo shirts, shirts, joggingpants, sweat pants, sweatshirts, hoodedsweatshirts, tracksuits, fleece tops and pullovers, jackets, vests; baseball caps, beanies; sports shoes, sneakers; sweat bands; belts

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition Proceeding 91215038

In the matter of Trademark Application No. 85904663

For the mark: MARSHAL A.R.T.

Publication Date: Aug. 27, 2013

Marshall Amplification PLC

v.

KIAICO, Inc.

COUNTERCLAIM TO CANCEL RN 3940239

The Applicant, KIAICO, Inc., a Delaware corporation with offices located at, 445 Park Avenue, New York, N.Y., United States, hereby submits a counterclaim to cancel Opposer's mark RN 3940239 for the grounds of likelihood of confusion, nonuse, and abandonment.

1. Applicant has accumulated common law rights, constructive application rights under Section 1 (b), and registration rights for clothing in IC:025 in the "MARSHAL" mark(s), U.S. MARSHAL A.R.T. (RN 3986050), U.S. MARSHAL American Renegade Tracker (RN 4072057), MARSHAL A.R.T. (SN 85904663), MARSHAL A.R.T. (SN 85904765) & MARSHAL A.R.T. American Renegade Tracker (SN 85904324) as early as December

- 1, 2007, the filing date of the U.S. MARSHAL A.R.T. application, See the TSDR records in Exhibits A-D.
2. The earliest date upon which Opposer is entitled to rely for purposes of priority in this opposition proceeding for clothing in IC 025 (First Use: 0 First Use In Commerce: 0, *Clothing, headwear and footwear, namely, T-shirts, polo shirts, shirts, jogging pants, sweat pants, sweatshirts, hooded sweatshirts, tracksuits, fleece tops and pullovers, jackets, vests; baseball caps, beanies; sports shoes, sneakers; sweat bands; belts*) is the June 11, 2010, the filing date of its asserted Section 44(e) application. See Section 7(c) of the Trademark Act.
3. Applicant KIAICO is the prior user in this opposition and as such, if there is a likelihood of confusion between Applicant's use of the 'Marshal A.R.T.' mark for clothing and Opposer's MARSHALL AMPLIFICATION mark for clothing, it is Opposer's mark RN 3940239 that should be cancelled.
4. Upon information and belief, Opposer has either never actively used the mark in question, or has permanently ceased all use of the MARSHALL AMPLIFICATION mark in connection with all of the goods registered. First Use: 0 First Use In Commerce: 0, *Clothing, headwear and footwear, namely, T-shirts, polo shirts, shirts, jogging pants, sweat pants, sweatshirts, hooded sweatshirts, tracksuits, fleece tops and pullovers, jackets, vests; baseball caps, beanies; sports shoes, sneakers; sweat bands; belts*.
5. For purposes of nonuse and/or an abandonment claim for a Section 44(e) application, Opposer had the period from the application date of June 11, 2010 to the registration date of April 5, 2011 to meet the use in commerce requirement. See *Imperial Tobacco*

Ltd. v. Philip Morris Inc., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990) and *Consolidated Cigar Corporation*, 65 U.S.P.Q.2d 1153 (TTAB 2002).

6. As of the date of the filing of this counterclaim, April 7, 2014, the three consecutive year period after registration has commenced with no use in commerce for all of the goods in the registration which constitutes prima facie evidence of abandonment. A presumption of abandonment based on three years nonuse may be invoked against a Section 44(e) registrant who never begins use of the mark or who discontinues using the mark.

Saddlesprings, Inc. v. Mad Croc Brands, Inc., 104 USPQ2d 1948 (TTAB 2012).

7. Upon information and belief, Opposer has either never actively used the mark in question, or has permanently ceased all use of the MARSHALL AMPLIFICATION mark specifically in connection with sneakers.
8. Upon information and belief, Opposer has either never actively used the mark in question, or has permanently ceased all use of the MARSHALL AMPLIFICATION mark in specifically in connection with belts.
9. Upon information and belief, by reason of the facts set for the above, and that Opposer has failed to use the mark for at least three consecutive years, Opposer has abandoned the registered mark within the meaning of 15 U.S.C. §§ 1064(3) and 1127.

By virtue of the foregoing, if MARSHALL AMPLIFICATION is permitted to remain on the Principal Register with all the rights and privileges conferred on it by its status as a Principal Registration, Applicant will be damaged, including its inability to secure a registration for its MARSHAL A.R.T. mark, and Opposer will enjoy unlawful gain and advantage to which it is not entitled under the Lanham Act, 15U.S.C. §§ 1051 etseq.

Submitted By: /MRKIAI/

Date: April 7, 2014

Dan Healy, CEO KIAICO Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer has been served on John A. Clifford by mailing said copy on April 7, 2014, via First Class Mail, postage prepaid to:

John A. Clifford, Esq.
Merchant & Gould, P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910

By: /MRKIAL/

Date: April 7, 2014

Dan Healy, CEO KIAICO Inc.